UNITED STATES PATENT AND TRADEMARK OFFICE

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10/814,536	03/30/2004	Jonathan J. Hull	20412-08421	6884

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FENWICK & WEST LLP	SINGH, SATWANT K
SILICON VALLEY CENTER	

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801 CALIFORNIA STREET	2625	
MOUNTAIN VIEW, CA 94041		

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/814,536	HULL ET AL.
	Examiner	Art Unit
	Satwant K. Singh	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 November 2006</u>.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-18,25 and 31-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>42</u> is/are allowed.

6)☒ Claim(s) <u>1,3-18,25,31-41,43 and 44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 March 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/06, 11/06, and 12/06</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the amendment filed on 08 November 2008.

Response to Arguments

2.   Applicant's arguments with respect to claims 1, 25, 31, and 32 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 41 states *"A method of improving print quality of a printer, comprising:*

receiving, by a printer, a first document of a first image; searching, by the printer,

a network in order to locate a similar image with better print quality; creating, by

the printer, a printable document equivalent to the first document, except that the

similar image with better print quality replaces the first image". Paragraph [0133]

of the specification discloses a Printer with embedded Image Search Engine, but the

specification fails to disclose how the searching is accomplished.

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: ***"determining which of the two images has the better print quality"***.

Allowable Subject Matter

7.   Claim 42 allowed.

8.   The following is a statement of reasons for the indication of allowable subject matter: The prior art of Simchik et al. and Reber et al teach "A method, comprising: receiving, by a printer, a document comprising a video recording". Simchik et al and Reber et al fails to teach a method, comprising: "segmenting, by the printer, the video recording into a set of video clips; providing by the printer, a user interface allowing the user to publish selected clips of the set of video clips; publishing on the Internet, by the printer, and responsive to user's selection in the user interface, the selected clips".

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1, 8-18, 25, 31-40, and 44 are rejected under 35 U.S.C. 102(e) as being

anticipated by Simchik et al. (US 6,856,415).

11.   Regarding Claim 1, Simchik et al disclose a method, comprising: receiving, by a

printer (Fig. 8, step 92, forward document to print), a document having a pointer (URL)

pointing to data that is not in the received document (Fig. 8, step 90, import URL list into

document); retrieving the data pointed to by the pointer (Fig. 8, step 94) (retrieve web

page); and creating by the printer, in response to retrieval of the data, a printable

document comprising at lest a portion of the document (Fig. 8, steps 94 and 96, insert

web page into document and print document) (col. 9, lines 56-67).

12.   Regarding Claim 3, Simchik et al disclose a method, further including storing, by

the printer in a database, the data pointed to by the pointer (saving URL list) (col. 8,

lines 66-67 and col. 9, lines 1-7).

13.   Regarding Claim 8, Simchik et al disclose a method, wherein the received

document is a PDL file (converting HTML data into a PDL file) (col. 6, lines 38-47).

14.   Regarding Claim 9, Simchik et al disclose a method, wherein the pointer is a

World Wide Web pointer (URL which defines a particular address of a web page) (col.

5, lines 48-50).

15.   Regarding Claim 10, Simchik et al disclose a method, wherein the pointer is a

URL (URL) (col. 5, lines 48-61).

16.   Regarding Claim 11, Simchik et al disclose a method, wherein the printable

document includes at least one frame gram of video data pointed to by the pointer

(moving video clips) (col. 4, lines 14-22).

17.   Regarding Claim 12, Simchik et al disclose a method, wherein the received document includes commands for the printer to perform a multimedia related action (multi-media objects) (col. 4, lines 14-22).

18.   Regarding Claim 13, Simchik et al discloses a method, wherein the printer analyses the received document to extract the pointer from the document (promoting system 10 dynamically and automatically retrieves the page content associated with URL and imports this content into the document) (col. 9, lines 58-67).

19.   Regarding Claim 14, Simchik et al disclose a method, wherein the document is received from a print-drive that processes the document to identify the pointer (hardware drivers for converting the PDL file to an appropriate format for printing) (col. 6, lines 50-56).

20.   Regarding Claim 15, Simchik et al disclose a method, wherein the document is received from a plug-in that processed the document to identify the pointer (content acquisition facility 22, which can be configured as a plug-in for the web browser) (col. 5, lines 43-45).

21.   Regarding Claim 16, Simchik et al disclose a method, wherein the document is received from a standalone application that processes the document to identify the pointer (web browser 24 by employing the URL can point to a file in a particular directory located on a particular web server in the web 14) (col. 5, lines 59-62).

22.   Regarding Claim 17, Simchik et al disclose a method, wherein the printer further interacts with a user before printing a document (user interface elements employed when collecting web pages) (col. 5, lines 23-45).

23.   Regarding Claim 18, Simchik et al disclose a method, further comprising: printing

the printable document (printing module 16 prints the document) (col. 7, lines 47-54);

and receiving input in accordance with the document printed by the printer and

retrieving multimedia data in accordance with the input (Fig. 5, steps 50 and 52) (user

creates a document and then launches a web browser to locate or select a web page)

(col. 7, lines 18-45).

24.   Regarding Claim 25, Simchik et al disclose a method, comprising: receiving by a

printer a document containing multimedia information (Fig. 8, step 92, forward

document to print); creating by the printer, in response to receipt of the document, a

printable document in accordance with the multimedia information (Fig. 8, steps 94 and

96, insert web page into document and print document) (col. 9, lines 56-67); and storing

by the printer at least some of the multimedia information in a database saving URL list)

(col. 8, lines 66-67 and col. 9, lines 1-7).

25.   Regarding Claim 31, Simchik et al disclose a method, comprising: receiving by

the printer a document containing multimedia information (Fig. 8, step 92, forward

document to print); and creating by the printer in response to receipt of the document, a

printable document in accordance with the multimedia information (Fig. 8, steps 94 and

96, insert web page into document and print document) (col. 9, lines 56-67) and

including at least one frame grab of video data in accordance with the multimedia

information (web page can include moving video clips) (col. 4, lines 14-22).

26.   Regarding Claim 32, Simchik et al disclose a method performed by a printer,

comprising: without being prompted by a manual user interface request (promoting

system 10 dynamically and automatically retrieves the web page content associated

with the URL and imports this content into the document) (col. 9, lines 58-67), gathering

information about multimedia data that is accessible to the printer; and creating a

summary of the accessible multimedia data (URL collection facility 22 provides for the

ability to create a URL list and then insert this list into a document) (col. 10, lines 1-10).

27.   Regarding Claim 33, Simchik et al disclose a method, further comprising: printing

the created summary (system dynamically and automatically retrieves the web page

content associated with the URL list at the time of printing).

28.   Regarding Claim 34, Simchik et al disclose a method, where the printer is

connected to a network and can access multimedia data via the network (integrated

printing system) (col. 3, lines 22-26).

29.   Regarding Claim 35, Simchik et al disclose a method, where the printer stores

multimedia data and the stored data is the data accessible by the printer (saving URL

list) (col. 8, lines 66-67 and col. 9, lines 1-7).

30.   Regarding Claim 36, Simchik et al disclose a method, where the printer has

access to a database containing multimedia data (list can be imported into the

document) (col. 8, lines 66-67 and col. 9, lines 1-7).

31.   Regarding Claim 37, Simchik et al disclose a method, where the summary

includes a representation of audio data (web page can include sound recordings) (col.

4, lines 14-22).

32.   Regarding Claim 38, Simchik et al disclose a method, where the summary
includes a representation of video data (web page can include moving video clips) (col.
4, lines 14-22).

33.   Regarding Claim 37, Simchik et al disclose a method, where the summary
includes a representation of graphical data (web page can include graphics) (col. 4,
lines 14-22).

34.   Regarding Claim 40, Simchik et al disclose a printer comprising: means for
receiving by a printer (Fig. 8, step 92, forward document to print), a document having a
pointer pointing to data that is not in the received document (Fig. 8, step 90, import URL
list into document); means for retrieving the data pointed to by the pointer (Fig. 8, step
94) (retrieve web page); and means for creating by the printer, in response to retrieval
of the data, a printable document containing at least a portion of the data pointed to by
the pointer (Fig. 8, steps 94 and 96, insert web page into document and print document)
(col. 9, lines 56-67).

35.   Regarding Claim 44, Simchik et al disclose a method, comprising: receiving, by
the printer, a file comprising URLs (Fig. 8, step 90, import URL list into document);
creating, by the printer, a printable document containing a summary of the contents,
where the summary includes retrieved multimedia data (Fig. 8, step 92, forward
document to print) (col. 9, lines 56-67).

36.   Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Shimoosawa
et al. (US 6,700,566).

37.   Regarding Claim 43, Shimoosawa et al disclose a method, comprising: providing,

by a printer, a user interface allowing a user to enter a World Wide Web search query

(browser input device 35 receives inputs to the browser functions such as URL inputs)

(col. 5, lines 52-55); executing, by the printer, the user-entered, World Wide Web search

query (performing processing according to the inputs) (col. 5, lines 52-55); creating, by

the printer, a printable document containing the results of the user-entered World Wide

Web search query, where the results are formatted so as to take advantage of the

printer's special capabilities (printer 23 prints outs various kinds of data such as images

and text) (col. 5, lines 29-30).

Claim Rejections - 35 USC § 103

38.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

39.   Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Simchik et al in view of Owen (US 7,075,676).

40.   Regarding Claim 4, Simchik et al fail to teach a method, further including the

pointer to the data as part of the printable document, wherein the printable document

includes both the data that is not in the received document and the pointer.

Owen teaches a method, further including the pointer to the data as part of the

printable document, wherein the printable document includes both the data that is not in

the received document and the pointer (actual information converted to and printed as

barcode) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill at the time of the

invention to have combined the teachings of Simchik with the teaching of Owen to

encode a portion of the print job.

41.   Regarding Claim 5, Simchik et al fail to teach a method, further including placing

a bar code in the printable document that represents at least some of the data pointed

to by the pointer, wherein the printable document includes both the data that is not in

the received document and the bar code.

Owen teaches a method, further including placing a bar code in the printable

document that represents at least some of the data pointed to by the pointer, wherein

the printable document includes both the data that is not in the received document and

the bar code (actual information converted to and printed as barcode) (col. 2, lines 55-

67).

Therefore, it would have been obvious to one of ordinary skill at the time of the

invention to have combined the teachings of Simchik with the teaching of Owen to

encode a portion of the print job.

42.   Regarding Claim 6, Simchik et al fail to teach a method, further indicating placing

a barcode in the printable document that represents a local storage location of at least

some of the data pointed to by the pointer, wherein the printable document includes

both the data that is not in the received document and the bar code.

Owen teaches a method, further indicating placing a barcode in the printable

document that represents a local storage location of at least some of the data pointed to

by the pointer, wherein the printable document includes both the data that is not in the

received document and the bar code (barcode may identify the machine upon which the

file is stored) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill at the time of the

invention to have combined the teachings of Simchik with the teaching of Owen to

encode a portion of the print job.

43.   Regarding Claim 7, Simchik et al fail to teach a method, further including placing

a barcode in the printable document that represents the pointer, wherein the printable

document includes both the data that is not in the received document and the bar code.

Owen teaches a method, further including placing a barcode in the printable

document that represents the pointer, wherein the printable document includes both the

data that is not in the received document and the bar code (information includes a file

identifier and a location) (col. 2, lines 55-67).

Therefore, it would have been obvious to one of ordinary skill at the time of the

invention to have combined the teachings of Simchik with the teaching of Owen to

encode a portion of the print job.

Conclusion

44.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
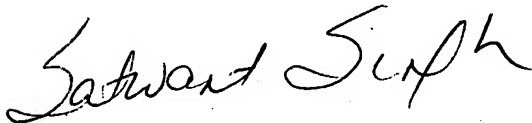
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Satwant K. Singh
Examiner
Art Unit 2625

sks

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600